

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SK Telecom, Ltd. : BEFORE THE  
Trademark: CELLPLAN : TRADEMARK TRIAL  
Serial No.: 78/101321 : AND  
Attorney: Andrew J. Park : APPEAL BOARD  
1900 K Street, N.W. : ON APPEAL  
Washington, D.C. 20006 :



09-22-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

APPLICANT'S APPEAL BRIEF

The applicant has appealed the trademark Examining Attorney's final refusal to register the trademark CELLPLAN on the grounds that (1) there is no likelihood of confusion within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), and (2) the mark is not descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

FACTS

The applicant filed a trademark application for the word mark CELLPLAN in plain block letters ("Applicant's Mark"). The application claims "computer software used for the transmission of electronic signals for wireless telephone, computer programs used for the transmission of electronic signals for wireless telephone, computer operating programs, computers, sound wave telegraph sets, carrier relay equipment, pagers and communication servers for computer hardware, wireless telephone, telephone transmitters of electronics signals" in International Class 9. This claim of goods is pursuant to the Examining Attorney's proposed and subsequently approved amendment to the goods description, as set forth in its Office Action of April 30, 2002 and its Final Refusal of January 22, 2003, respectively.

The Examining Attorney refuses to register the Applicant's Mark on the grounds that (1) it is likely to cause confusion and (2) it is descriptive. As the record shows, and as argued hereinbelow, the claimed goods and services of the two competing marks are distinctly different and, the additional elements of the cited mark, including the use of a unique logo and additional word terms, renders the two marks dissimilar when each mark is viewed as a whole. Therefore, there is no likelihood of confusion because the consumers and the channels of trade of the respective goods are different and the marks are distinguishable.

Further, the Applicant's Mark does not and, indeed, cannot impart any reasonable meaning that would be descriptive of the claimed goods and, therefore, the Applicant's Mark cannot be descriptive.

## ARGUMENT

### I. NO LIKELIHOOD OF CONFUSION

The Examining Attorney determined that the Applicant's Mark so resembles the registered "CELPLAN WIRELESS GLOBAL TECHNOLOGIES (and design element)" mark (Reg. No. 2014985) ("Registrant's Mark") as to be likely to cause confusion based upon the finding that the goods of the Applicant's Mark are related to the services of the Registrant's Mark and, the pronunciation and appearance of the two marks are similar.

The issue of the likelihood of confusion must be determined not only on the basis of an evaluation of the pronunciation, appearance, etc. of the marks themselves, but also on the basis of an evaluation of the goods/services of the respective marks.

1. The goods claimed by the Applicant's Mark and the services claimed by the Registrant's Mark are different and unrelated in all respects, including (a) function/purpose; (b) end-products; and (c) intended consumers/channels of trade. For this reason, there is no likelihood of confusion as to the origin of the goods and services bearing the respective marks.

(a) In the Office Action, the Examining Attorney found that the goods of the Applicant's Mark are "highly related" to the services of the Registrant's Mark based upon the belief that both marks are "used in connection with cellular phones." Then, in the Final Refusal, the Examining Attorney found that the services of the Registrant's Mark and the goods of the Applicant's Mark are similar because both are used in connection with the "telecommunications field."

As argued in the Response to the Office Action, the Examining Attorney erred in finding that the goods of the Applicant's Mark are similar to the services of the Registrant's Mark because the Registrant's Mark simply does not claim any matter that would even suggest involvement with cellular telephones. Now, in the Final Refusal, the Examining Attorney believes that the goods and services of the Applicant's Mark and the Registrant's Mark, respectively, should be considered similar on the grounds that both are used in connection with the "telecommunications field." The description "telecommunications field" is so broad and vague that it is impossible to know whether it relates to cellular phones. The Examining Attorney did not have any reasonable basis to make the assumption that "telecommunications field" includes uses relating to cellular phones. Moreover, the Examining Attorney relies on the Registrant's web site in an effort to show that the Registrant is, in fact, involved in the field of cellular phones. Although it is unknown whether the Registrant is, in fact, involved with cellular phones, the issue is not what the Registrant may be involved in now, but rather what the Registrant's Mark claims in terms of its services. The Examining Attorney should not be permitted to make assumptions on the scope of the "telecommunications field" on the basis of the Registrant's current web site. After all, the scope of the protection of a registered mark is dictated by the claim of its services and not by the scope of the registrant's business activities.

(b,c) The Applicant is a leader in the area of the development of new technologies for the transmission of systems and methods of delivery of signals for wireless phones and related

technology, including for example, CDMA technology. It is among an elite and small group of companies worldwide that is capable of developing the standards by which cell phones operate, among other things. In contrast, the Registrant appears to be involved in assisting wireless networks in terms of optimizing, integrating and supporting base technologies which are developed by companies such as the Applicant. This is evidenced by the excerpts of the internet concerning both the Applicant and the Registrant which the Examining Attorney attached to its Final Refusal. Thus, the goods claimed by the Applicant's Mark are clearly dissimilar to the services claimed by the Registrant's Mark and, as a result, the intended consumers and the channels of trade for the respective goods and services are entirely different.

(2) There are distinct dissimilarities between the marks themselves. The Registrant's Mark is composed of two dominant and distinctive elements - the tri-cubed design and the CELPLAN word. In addition, the Registrant's Mark is composed of the "Wireless Global Technologies" phrase (disclaimed). In contrast, the Applicant's Mark is composed solely of the CELLPLAN word - it has no other logo or design that could create confusion with the Registrant's Mark.

When each mark is viewed as a whole, it is clear that the Applicant's mark is dissimilar to the Registrant's Mark. The use of the tri-cubed design together with the disclaimed word portion and the combination of the overall placement/arrangement of the three different elements and the stylization of the letters of the word elements that comprise the Registrant's Mark create an overall visual impression, meaning and pronunciation that is distinct from the Applicant's Mark.

In summary, the combination of (1) the differences between the goods of the Applicant's Mark and the services of the Registrant's Mark; (2) the differences between the overall goods and services of the Applicant and Registrant companies; (3) the differences between the intended consumers and channels of trade; and (4) the differences between the marks themselves, when viewed as a whole, require a finding that there is no likelihood of confusion within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d).

## II. NON-DESCRIPTIVE

The Examining Attorney held in its Office Action that the Applicant's Mark is descriptive of one of the features of its goods by finding that "the Applicant's goods are likely to enable the use of cell phones that are connected with particular calling plans." In response, the Applicant argued that based on the specific goods claimed by the Applicant's Mark and as a practical matter (based on fundamental principals of technology), there are no facts to support the finding that "the Applicant's goods are likely to enable the use of cell phones that are connected with particular calling plans."

Of the various goods claimed by the Applicant's Mark, those that are related to wireless telephones are specifically for computer software/computer programs for "the transmission of electronic signals." They are not and cannot be related to cell phones that are "connected with particular calling plans" since they concern the transmission of electronic signals and have no relation to calling plans.

The Examining Attorney then held in its Final Rejection that the Applicant's Mark is descriptive because it describes a feature of the goods. The Examining Attorney does not indicate the descriptive nature and, instead, wrongly believes that the Applicant "implies that since the mark is not descriptive of all of the goods that therefore, it is not descriptive at all."

First, this suggests that the Examining Attorney accepts the Applicant's argument that its mark is not descriptive of a cellular phone calling plan.

Second, a review of Applicant's response to the Office Action will show that the Examining Attorney's belief that the Applicant "implies that since the mark is not descriptive of all of the goods that therefore, it is not descriptive at all" is not correct. This is clearly not what the Applicant argued and certainly did not "imply." Rather, it was a direct response to the Examining Attorney's claim in its Office Action that the Applicant's mark is descriptive of cell phones that are connected with particular calling plans.

Third, in addition to the fact that the Applicant's Mark "cannot be related to cell phones that are 'connected with particular calling plans' since they concern the transmission of electronic signals and have no relation to calling plans," it is equally clear that the mark cannot be considered to have any reasonable relationship to any of its other claimed goods. To find otherwise would require a leap of logic that would be tenuous at best. In fact, to repeat, even the Examining Attorney does not indicate in its Final Refusal how the Applicant's Mark is descriptive of any of the claimed goods.

Finally, while information obtained from the web can be probative, there are limitations. In this case, the Examining Attorney relies on web-articles concerning the Applicant's use of its Mark in order to support the claim that the Applicant's mark is descriptive. The issue and the focus, however, is not how the applicant's mark may be used in foreign jurisdictions, but rather, how the Applicant plans to use its mark in the United States, as indicated in its trademark application. In this regard, it is clear from the Applicant's trademark application that it intends to use its mark on specific and narrowly-described goods and, as argued above, none of the claimed goods are similar to the clear and understandable reading of the services that are claimed by the Registrant's Mark.

#### IV. CONCLUSION

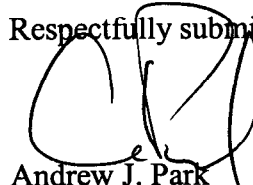
The combination of (1) the differences between the goods of the Applicant's Mark and the services of the Registrant's Mark; (2) the differences between the overall goods and services of the Applicant and Registrant companies, respectively; (3) the differences between the intended consumers and channels of trade; and (4) the differences between the marks themselves, when viewed as a whole, require a finding that there is no likelihood of confusion within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d).

Further, the Applicant's Mark is not descriptive of a cellular phone calling plan nor any of the goods which it claims and, in fact, the Examining Attorney fails to indicate how the Applicant's

mark is descriptive in connection with particular goods. Thus, the Applicant's Mark is not descriptive within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. Section 1052(e)(1).

For the foregoing reasons, the Examining Attorney's refusal to register the Applicant's Mark should be reversed and, since all other grounds of the Office Action have been remedied and accepted by the Examining Attorney, it is respectfully requested that the Applicant's Mark be deemed to be fit for publication.

Respectfully submitted,



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Attorney for Applicant



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**VIA COURIER, POSTCARD ATTACHED**

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09-22-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

Re: Appeal of Trademark Examining Attorney's Final Refusal  
Trademark Application Serial No. 78/101,321  
Applicant: SK Telecom  
Mark: CELLPLAN  
Filing Date: January 7, 2002  
Attorney Reference No.: 6503.001

Dear Sir/Madam:

Enclosed herewith is the Applicant's Appeal of Trademark Examining Attorney's Final Refusal in connection with the above-referenced matter.

Respectfully,

Andrew J. Park

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Enclosure (Appeal of Trademark Examining Attorney's Final Refusal)

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